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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,841	08/02/2001	Alain Rambach	1567P368	8188

7590 01/09/2004

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EXAMINER

MARX, IRENE

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/890,841	RAMBACH ET AL.	
	Examiner	Art Unit	
	Irene Marx	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

The application should be reviewed for errors and conformity with domestic practice. Error occurs, for example, in the spelling of "galatosidase" in claim 6.

The election without traverse filed 10/27/03 is acknowledged. Claims 1-9 and 25-27 are being considered on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and 25 is vague, indefinite and confusing in the recitation "indoxyl derivative", since the "derivatives" intended are not defined with any specificity are these chemical, physical or biological "derivatives"?

Claim 4 is vague, indefinite and confusing in the use of abbreviations for the substrates. The full chemical name should be provided. No new matter may be added.

Claim 6 is vague and indefinite in the recitation of "aerobic anaerobic bacteria". It is unclear what is intended.

Claim 8 is vague and indefinite in the use of parenthesis, since it is unclear whether the parenthetical material is or is not intended to be part of the claim.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd.

App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim s 4-6, 7, 9 and 25 recite a broad recitation, and the claim also recites "preferably" or "in particular" which is the narrower statement of the range/limitation.

Claim 25 is vague, indefinite and confusing in the recitation "which may contain bacteria, cultured under anaerobic conditions"

Claim 26 vague and indefinite in containing a culturing step in a composition claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sellers.

The present application relates to a bacteria culture medium including a metal complex enabling the oxidative polymerization of an indoxyl derivative and a substrate containing an indoxyl derivative, leading to an insoluble colored compound.

Sellers describes a culture medium for the identification of *Proteus* and *Providencia* enteric bacterial strains using a combination of L-tryptophan (a compound including an indole ring) with ammonium ferric citrate and "Brom cresol purple" (Abstract). In this culture medium, the tryptophan deamination reaction catalyzed by a bacterial enzyme causes the formation of

non-metabolizable colored complexes that provide a permanent colored indication of the presence of cells of *Proteus* and *Providencia* (Column 3, lines 28-35). Thus the medium comprises an enzyme and may contain bacteria. The reference also teaches a medium containing 0.5 g/l of ammonium ferric citrate (column 3, lines 36-50). The intended use of "anaerobic conditions" does not affect patentability. In any event, the media disclosed in the reference is suitable for use under anaerobic conditions.

Claims 1-9 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sellers taken with Chevalier *et al.* and Difco Manual.

Sellers is discussed above.

The reference differs from the claimed invention in the use of magnesium sulfate and/or an antibiotic in the medium and in the use of cysteinated Columbia medium. However, Chevalier discloses a similar medium for the detection of bacteria, such as Lactobacilli MRS medium which contains magnesium sulfate in combination with chromogenic substrates for the detection of α -galactosidase (See, e.g., Chevalier, page 77, Difco Manual, pages 246-247). Moreover, Chevalier *et al.* disclose that the use of antibiotics in selective media is a well known technique in the art (See, e.g., page 76, paragraph 1).

In addition, the use of cysteinated Columbia medium is old and well known in the art, as adequately demonstrated by Difco Manual (See, e.g., pages 125-126). Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the medium of Sellers by replacing sodium thiosulfate with magnesium sulfate in the medium or by using cysteinated Columbia medium in conjunction with chromogenic substrates with or without antibiotics for the expected benefit of providing a medium capable of selectively detecting deleterious bacteria.

Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is 703-308-2922. The examiner can normally be reached on M-F (6:30-3:00).

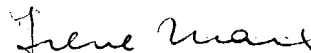
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 703-308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0926.



Irene Marx
Primary Examiner
Art Unit 1651